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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/649,699 | 08/28/2003 | Motohiro Sugiura | WEN-0021 | 6748 |
| 23353 | 7590 | 09/16/2005 | EXAMINER | |
| RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036 | | | JOHNSON III, HENRY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,699

Applicant(s)

SUGIURA, MOTOHIRO

Examiner

Henry M. Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed August 12, 2005 have been fully considered but they are not persuasive. Gray et al. teach the tracking of the translation and rotation ("cyclotortion") of an eye as a patient is moved from the upright measuring position to the prone surgery position as well as tracking eye movement during surgery. Detection of these movements is used to calculate error signal used to correct the orientation of the surgical laser.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,702,806 to Gray et al. Gray et al. teach that it is well known that the eye undergoes movement within the socket comprising translation and rotation ("cyclotortion") as the patient is moved from the upright measuring position to the prone surgery position (Col. 1, lines 47-50). The applicant refers to this movement as torsion. Gray et al. teach an orientation system for corrective eye surgery using a first image taken in a first patient position (upright) and a second image taken with the patient in a second position (prone) wherein a feature is marked on the eye and used as an alignment point (abstract) for accommodating eye movement such as that known to occur as a patient is moved from an upright measuring position to the prone surgery position (Col. 1, lines 40-41). A pen is used to make two alignment marks on the eye. The eye is imaged with the patient in another position, and the image displayed. Natural features of the eye may be used as an alternative to marking the eye. A computer is used to provide alignment with the marks on the eye (mark detection) and a reference reticle (col. 8, lines 5-15). Another

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software program calculates an oriental change to be applied to a laser beam (Col. 8, lines 30-37). These are interpreted as a unit (CPU and software) for torsion detection. The laser coordinates are reoriented (torsion correction means/unit) to accommodate for the rotation and translation that took place when moving the patient from the upright to the prone position (Col. 5, lines 13-16). It should be noted that the torsion detection structure is present and the time it is implemented (before or during surgery) does not impact the structure, as it is intended use. However, Gray et al. further disclose an eye tracking capability with the treatment laser to adjust for eye movements during surgery (Fig. 9, # 54).

Conclusion

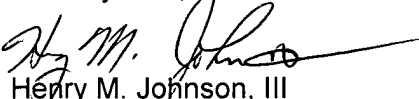
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication US 2005/0119642 to Grecu et al. teach it is essential to correctly register the position of the person's eye, i.e. to determine the translational and rotational displacement of the eye with respect to its position during diagnosis, so that the system "knows" how to apply the previously calculated ablation profile to the cornea in its momentary position and discloses a system and methods for achievement of these objectives.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent ,
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private
PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry M. Johnson, III
Primary Examiner
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